

**REMARKS**

Claims 1, 2, 4, 5, 7, 9, 11, 12 and 14 are all the claims pending in the application after entry of the foregoing amendments. Claims 3, 6, 8, 10, 13 and 15 are hereby canceled.

**35 U.S.C. § 102:**

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,875,035 to Motosugi et al.

Applicant submits that the features of claims 1 and 9 provide a novel image forming method and system, as emphasized in the Response dated December 23, 2004. To expedite prosecution, claims 1 and 9 are amended to further define the claimed editing step. In particular, claim 1 recites, *inter alia*:

“wherein the editing step is operative to effect a scaling process to fit the image located in the image extracted area of the second original to the image composited area of the first original by comparing the size of the image composited area with the size of the image extracted area.”

Claim 9 recites, *inter alia*:

“wherein the editing device is operative to compare a size of an image composited area of the first original indicated by the coordinate input device with a size of an image extracted area of the second original, thereby effecting a scaling process operative to fit an image located in the image extracted area to the image composited area.”

Motosugi does not teach at least the claimed scaling process, nor the combination of features recited in claims 1 and 9. Instead, Motosugi discloses:

In case of pasting a second original image which is smaller than a first original image on the first original image, for example, the destination original (first original) and the pasted original (second original) are displayed on the color LCD 115, and the *image areas of these*

*originals are calculated.* In response to the relation between these areas, the destination and pasted original images are automatically determined *so that the image (pasted original image) having a smaller area is displayed in preference to the image (destination original image) having a larger area*, i.e., the former is displayed on the latter. In this case, it is possible to prevent such a phenomenon that the image (pasted original image) is under the image (destination original image) having a larger area and disappears from the display screen. Thus, the operator will not miss the image having a smaller area on the display screen.

*See col. 16 line 57-col. 17, line 13, of Motosugi.*

In effect, Motosugi teaches to compare two images so that a smaller image is not “*under the image (destination original image) having a larger area and disappears from the display screen,*” as explicitly noted in the above-passage of Motosugi. As one skilled in the art of imaging processing would appreciate, “scaling” involves either enlarging or reducing the size of an object. This is also consistent with the exemplary embodiment of the present specification that describes a scaling factor that is output to the image processing device, which enlarges or reduces the image data size, as described on page 20, lines 20-28. Motosugi does not disclose to compare images or image data so as to increase or decrease an image’s size. The mere existence of one image being larger than another, as in Motosugi, does not constitute a scaling process and does not disclose the features of claims 1 and 9.

Therefore, Applicant submits that Motosugi does not disclose each feature of claims 1 and 9 and requests that the rejection under 35 U.S.C. § 102(b) be withdrawn. The rejection of claims 2, 4, 5, 7, 9, 11, 12 and 14 should also be withdrawn at least because of these claims respectively depending from claims 1 and 9.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

AMENDMENT UNDER 37 C.F.R. §1.116  
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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

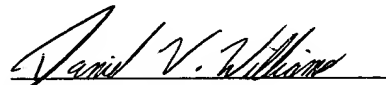
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**23373**

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